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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/557,580	03/24/2006	Hisanori Akiyama	125973	9054

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EXAMINER

MINSKEY, JACOB T

ART UNIT	PAPER NUMBER
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1741

NOTIFICATION DATE	DELIVERY MODE
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ELECTRONIC

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

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Office Action Summary	Application No. 10/557,580	Applicant(s) AKIYAMA, HISANORI	
	Examiner JACOB T. MINSKEY	Art Unit 1741	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 08 November 2010.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-5 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-5 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date <u>10/14/2010</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Response to Arguments

1. Applicant's arguments filed 11/08/2010 have been fully considered but they are not persuasive.
2. The amendment to the claims focus on the new limitation of the geometric center of the circular lens member corresponds to the associated sub-frame center and the geometric center of the edge shape. This limitation is alluded to in the line preceding it in claim 1 where distance between the optical center and geometric center of the circular lens member.
3. Applicant argues that the Kennedy reference remains silent on the geometric center of the lens blank and only focuses on the geometric center of the edged lens. Therefor, the reference does not provide the relationship between the geometric center of the lens blank and the edged lens.
4. In this regards the Examiner respectfully disagrees. First of all, the claims do not actively state what the relationship between the two centers is, only that they correspond. From the specification it is understood by the Examiner that it is intended that the geometric centers are as close as possible to the same point in order to reduce waste in the production process.
5. The Kennedy reference does not expressly provide for the geometric center of the edge shape, but does teach that the forming step comprises using the order information to first set the geometric center, then to calculate the position of the optical center based off of provided information such as pupil distance, frame distance,

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distance between lenses, and other provided measurements (column 6 line 42 – column 8 line 4, and figures 8 and 9). The method of Kennedy demonstrates the known method of setting a lens blank by its geometric center and then forming the optical center from that point utilizing provided measurements to form both lenses in a special frame. It would have been understood that the steps of centering the geometric center would have taken the geometric center of the edge shape into consideration during this step. The teachings of setting the geometric center of the lens blank first (and the further descriptions on how block the settings and form the lens) would be sufficient enough of a teaching to allow an average artisan to understand the importance of centering the lens blank. This would implicitly include centering it under all considerations (both with frame center and the edge shape) so that it is true positing based on the geometric center considerations as a whole to provide the listed advantages of Kennedy.

6. The arguments presented do not persuade the Examiner in view of the Kennedy reference.

Claim Rejections - 35 USC § 102/103

7. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

8. A person shall be entitled to a patent unless –

9. (b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

10. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

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a. A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

11. The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148

USPQ 459 (1966), that are applied for establishing a background for determining

obviousness under 35 U.S.C. 103(a) are summarized as follows:

12. Determining the scope and contents of the prior art.
13. Ascertaining the differences between the prior art and the claims at issue.
14. Resolving the level of ordinary skill in the pertinent art.
15. Considering objective evidence present in the application indicating obviousness or nonobviousness.

16. Claims 1 and 3 are rejected under 35 U.S.C. 102(b) as being anticipated by or in the alternative as obvious under 35 U.S.C. 103(a) by Kennedy, USP 5,425,665.

17. Regarding claim 1, Kennedy teaches a method and apparatus for manufacturing a spectacle lens (see title) sets based on order information (see figure 8 and column 1 lines 21-44) comprising a lens forming step of forming a circular plastic material (see column 1 describing attaching lens material to block) where the block aides in forming the shape of the lens by positing it to be processed in the desired shape (see summary of invention, column 2), wherein the lens member is a lens blank (item 44, figure 2 and column 4 line 30) and that the forming step comprising using the order information to first set the geometric center, then to calculate the position of the optical center based off of provided information such as pupil distance, frame distance, distance between lenses, and other provided measurements (column 6 line 42 – column 8 line 4, and

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figures 8 and 9). The method of Kennedy demonstrates the known method of setting a lens blank by its geometric center and then forming the optical center from that point utilizing provided measurements to form both lenses in a special frame.

18. The method of Kennedy demonstrates the known method of setting a lens blank by its geometric center and then forming the optical center from that point utilizing provided measurements to form both lenses in a special frame. It is implicitly taught that the steps of centering the geometric center take the geometric center of the edge shape into consideration during this step. The teachings of setting the geometric center of the lens blank first (and the further descriptions on how block the settings and form the lens) provides an understanding of the importance of centering the lens blank. This would implicitly include centering it under all considerations (both with frame center and the edge shape) so that it is true positing based on the geometric center considerations as a whole to provide the listed advantages of Kennedy.

19. In the alternative, one of ordinary skill in the art at the time of the invention would have found it obvious to set the geometric center of the lens member in direct relation to both the geometric center of the lens sub frame and the lens edge shape so that the lens member would be centered from all positions so the formation steps are preformed more efficiently.

20. Regarding claim 3, Kennedy further teaches that a computer is utilized to control the positing of the block and blank so that the angle, distance in X direction, and distance in the Y direction is automatically controlled to block out the lens during rotation and formation (columns 7 and 8).

Claim Rejections - 35 USC § 103

21. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

b. A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

22. The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

- 23. Determining the scope and contents of the prior art.
- 24. Ascertaining the differences between the prior art and the claims at issue.
- 25. Resolving the level of ordinary skill in the pertinent art.
- 26. Considering objective evidence present in the application indicating obviousness or nonobviousness.

27. Claims 2 and 4-5 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kennedy, USP 5,425,665 in view of Miyazawa et al, US Patent Publication 2003/0181133.

28. Regarding claims 2 and 4, Kennedy implicitly teaches that the blank utilized has a smallest diameter that is at least as big as the maximum distance of the order is performed by the QC check at the bottom of column 7. The ordinary artisan practicing the Kennedy process would have found it obvious to have the blank had to be at least as big as the order in order for the product to be produced

29. Kennedy remains as applied in claim 1 above, but is silent on the limitations of selecting a blank from a pool of blanks that are prepared in advance.

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30. In the same field of endeavor of forming spectacle lenses through controlling the optical center of the final product, Miyazawa is utilized for the sole purpose to show that it is known in the art at the time of the invention to provide a selection of lens blanks made in advance to be selected for the formation steps of the actual lens.

31. Miyazawa teaches that the lens member forming step uses a lens blank (semi-finished lens, [0044]) of which both the surface have not yet processed to the curved surface shape satisfying the optical specification of the spectacle lens related to the order [0044] but processed to a predetermined surface shape as the plastic material of a processing target, and is able to process the spectacle lens related to the order appropriately out of a plurality of lens blanks manufactured and prepared in advance [0044-0045], and wherein the lens blank having an outside diameter at least larger than a maximum distance between a frame center and a frame of the spectacle frame related to the order and having the smallest outside diameter as well ("the semi-finished lens, therefore has a thickness relatively larger than a finish thickness" [0044]) is selected and processed so that the spectacle lens related to the order is manufactured (optimum semi-finished lens to be machined is selected from the stock [0045]).

32. It would have been obvious to one of ordinary skill in the art at the time of the invention to utilize Miyazawa's process of making blanks in advance to be readily utilized by the main process in the Kennedy method for the benefit of having a blank with all known values already prepared prior to lens shaping. "The combination of familiar elements according to known methods is likely to be obvious when it does no

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more than yield predictable results.” KSR Int’l Co V. Teleflex Inc, 127 S.Ct. 1727, 82 USPQ2d 1385 (2007).

33. Regarding claim 5, Kennedy further teaches that a computer is utilized to control the positing of the block and blank so that the angle, distance in X direction, and distance in the Y direction is automatically controlled to block out the lens during rotation and formation (columns 7 and 8).

Conclusion

34. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to JACOB T. MINSKEY whose telephone number is (571)270-7003. The examiner can normally be reached on Monday to Friday 7:30-5:00 EST.

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Matthew Daniels can be reached on 571-272-2450. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

JTM

/Matthew J. Daniels/
Supervisory Patent Examiner, Art Unit 1741